

REMARKS

A Request for Continued Examination and the accompanying fee is submitted herewith. Entry of the Declaration under 37 CFR § 1.132 and the following remarks are respectfully requested. Reconsideration of the application and withdrawal of the rejections in view of the amendments and following remarks is respectfully requested.

Status of the Claims

Claims 1, 3, 5 and 13-20 are pending in the application. Claims 2, 4 and 6-12 have been cancelled without prejudice or disclaimer. Claims 1, 3, 5, 13, and 15-20 were previously presented.

Advisory Action

The Advisory Action dated October 27, 2009 indicated that the amendments filed with the Response to the Final Office Action, filed October 19, 2009, were entered. The listing of claims presented herein, is a reflection of the entered amendments.

The Examiner has rejected claims 1, 3, 5, 13-15, 17, 18 and 20. The Examiner's reasoning in the Advisory Action is as follows:

Applicant argues that "the '516 patent describes 'the excellent effects of the compounds according to the present invention' thereby teaching away from making any substitutions to the compounds. This does not amount to a teaching away, therefore the request for reconsideration is not persuasive. In addition, with respect to the declaration, applicants arguments with respect to the statistical significance are not persuasive, in part because evidence of this sort is properly presented in a declaration and the t-test does not show how unpredictable activities are when structures vary substantially.

In response, Applicants file herewith, a declaration under 37 CFR § 1.132 by Applicant Seiichi Uchida. The Examiner rejected claims 1-3, 5, 6, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over US 6,342,516 ('516) in the Office Action dated July 23, 2009. The Declaration demonstrates the differences in effects on the eye subjected to light irradiation between

the instant invention and the cited '516 patent. The compounds tested were “Compound 37” of the present application and that of “Compound 3-19” of ‘516 patent. The results, summarized in the Table on page 4, show that Compound 37 increased the recovery rate in a significant manner (18.6 vs. -1.1; 45.0 vs. 5.1) which could not be foreseen or rendered obvious by any teachings of the '516 application. In fact, one of ordinary skill in the art would not be motivated to even try to experiment or identify any substitutions of the compounds based on the teachings of the '516 patent either alone or in combination with Patani *et al.* The '516 patent, in view of Patani, does not provide any specific compound having the instant substitutions with the unexpected protective effects on the retina against photodamage. Accordingly, Applicants submits, that the present invention is not rendered obvious by the ‘516 patent in view of Patani *et al.*

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

CONCLUSION

Based on the above amendments and arguments, the subsisting claims are believed to be in condition for allowance, and such action is earnestly solicited. If there are remaining issues that the Examiner believes could be addressed by conducting an interview or entering an Examiner’s Amendment, the Examiner is cordially invited to contact the undersigned agent to discuss such issues at telephone number shown below.

The Commissioner for Patents and Trademarks is hereby authorized to charge the amount due for any retroactive extensions of time and any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees paid on the filing or during prosecution of this application to Deposit Account No. 04-0100.

Application No. 10/553,108
Amendment dated January 19, 2010
After Final Office Action of July 23, 2009

Docket No.: 20241/0203481-US0

Dated: January 19, 2010

Respectfully submitted,

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